

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: August 24, 2005

Opposition No. **91165689**

Pietrantonni Mendez & Alvarez
LLP

v.

Bodies In Motion, Inc.

Peter Cataldo, Attorney:

A request for extension of time to oppose the registration of application Serial No. 76578388 was filed on May 23, 2005 by Pietrantonni Mendes & Alvarez LLP.

Thereafter, on June 27, 2005, Pietrantonni Mendes & Alvarez LLP filed its notice of opposition that was instituted on June 28, 2005 as the instant proceeding. Subsequently, on July 14, 2005, opposer filed a motion to substitute Zen Spa Enterprises, Inc. as opposer herein.

A request for a further extension, or an opposition, filed by a different party will not be rejected on that ground if it is shown to the satisfaction of the Board that the different party is in privity with the party granted the previous extension. See Trademark Rule 2.102(b). The "showing" should be in the form of a recitation of the facts upon which the claim of privity is based, and must be submitted either with the request or opposition, or during

the time allowed by the Board in its action requesting an explanation of the discrepancy. See TBMP §206.02 (2d ed. rev. 2004) and the authorities cited therein.

Further, a request for a further extension, or an opposition, filed in a different name will not be rejected on that ground if it is shown to the satisfaction of the Board that the party in whose name the extension was requested was misidentified through mistake. See Trademark Rule 2.102(b). See also *Cass Logistics Inc. v. McKesson Corp.*, 27 USPQ2d 1075 (TTAB 1993). The phrase "misidentification by mistake," as used in Trademark Rule 2.102(b), means a mistake in the form of the potential opposer's name or its entity type, not the naming of a different existing legal entity that is not in privity with the party that should have been named. See *Custom Computer Services, Inc. v. Paychex Properties, Inc.*, 337 F.3d 1334, 67 USPQ2d 1638 (Fed. Cir. 2003); and *Cass Logistics Inc. v. McKesson Corp.*, *supra*. The "showing" submitted in support of a claim of misidentification by mistake should be in the form of a recitation of the facts upon which the claim of misidentification by mistake is based, and must be submitted either with the request or opposition, or during the time allowed by the Board in its letter requesting an explanation of the discrepancy. See TBMP §2.06.03 (2d ed. rev. 2004) and the authorities cited therein.

In this case, opposer has made no showing of privity between Pietrantonio Mendes & Alvarez LLP and Zen Spa Enterprises, Inc. That is to say, opposer has failed to set forth facts to establish that Zen Spa Enterprises, Inc. is a successor in interest to Pietrantonio Mendes & Alvarez LLP. Further, the Board finds that the proposed substitution does not address a mere mistake in identification of the form of opposer's name or entity type, but rather names a distinct and separate party as opposer. As such, there is nothing in the record to support opposer's requested substitution of Zen Spa Enterprises, Inc. as party plaintiff herein.

Accordingly, opposer's motion to substitute is hereby denied.

In consequence thereof, proceedings herein are suspended and opposer, Pietrantonio Mendes & Alvarez LLP, is allowed thirty days in which to affirm its standing to bring this opposition proceeding, failing which, the instant opposition will be dismissed in accordance with Fed. R. Civ. P. 12(b)(6).